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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,291	10/19/2001	Hiroo Okamoto	500.40766X00	7854

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EXAMINER

TOPGYAL, GELEK W

ART UNIT PAPER NUMBER

2621

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/982,291	<b>Applicant(s)</b> OKAMOTO ET AL.	
	<b>Examiner</b> Gelek Topgyal	<b>Art Unit</b> 2621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-29, 41, 42 and 50-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-22, 24, 26-29, 41, 42 and 50-54 is/are rejected.
- 7) ☒ Claim(s) 23 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 16-29, 41-42, and 50-54 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 16-22, 24, 41-42 and 50** are rejected under 35 U.S.C. 102(e) as being anticipated by Ichimura et al. (US 6,034,832).

**Regarding claim 16**, Ichimura et al. teaches a digital information recording for recording digital information including video information and/or audio information on a first recording medium, comprising:

a recording circuit for recording information of a copy permission period included in said digital information (Fig. 5, "DATE-AND-HOUR CONDITION DATA", and col. 10, lines 39-58 and col. 9, lines 48-58 teaches "copy date and hour condition data" stored in CMD data that can be recorded onto the source medium or on the copied medium);

said copy permission period specifying a predetermined time period for permitting said digital information recorded on said first recording medium to be copied

(Col. 10, lines 39-58 teaches several different permission periods (within CMD data) during which a copy from a source medium can be made onto a second medium) and recorded only once from said first recording medium onto a second recording medium different from said first recording medium after recording of said digital information on said first recording medium (Fig. 5, "FREQUENCY CONDITION DATA" and "GENERATION CONDITION DATA" and Col. 11, lines 6-30 teaches another set of data called "frequency condition data" and "generation condition data" which are stored in the CMD data. Therefore, the generation condition data maybe set to allow only two generations, therefore, after the source disc is copied a first time, and as taught in col. 9, lines 49-58, the CDM data is updated with new generation condition data in both the source medium (original copy) and the copied medium (second copy). Since the original and the copied audio-visual content are of second generation, neither of them are allowed to be reproduced or reproduced for copying. Therefore, the copying operation meets the limitation of "recorded only once from said first recording medium onto a second recording medium").

**Regarding claim 17**, Ichimura et al. teaches a digital information reproducing apparatus for reproducing digital information including video information and audio information from a first recording medium on which said digital information is recorded, said digital information including information of a copy permission period specifying a predetermined time period for permitting said digital information to be played back and recorded only once from said first recording medium to a second recording medium different from said first recording medium after recording of said digital information on

said first recording medium, said apparatus comprising (Rejected for the same reasons as discussed above in claim 16):

a detection circuit for detecting said copy permission period from the reproduced digital information (col. 4, lines 45-49 teaches of a controller 11 that controls the CMD data read from the source disc 1. Also in col. 5, lines 46-60 teaches of an encoder 23 in conjunction with the controller to detect any CMD data transmitted with the audio-visual data (DT data). The CMD data includes "date and hour condition data", "generation condition data", and "frequency condition data"); and

a control circuit for controlling, on the basis of the information of said copy permission period detected by said detection circuit, an operation for delivering the played back digital information to said second recording medium so as to copy and record said played back digital information onto said second recording medium (Col. 4, lines 35-44 and col. 6, lines 3-11 teaches of controllers 11 and 21 that makeup the reproducing portion and the recording portion of the system to allow the audio-visual information from the source medium to be copied onto another medium).

**Claim 18** is rejected for the same reasons as discussed in claim 17 above, and furthermore, when the date and hour condition data within the CMD data has passed the current date and time (several types of time limits are available), the recording cannot take place (col. 10, lines 39-58 and col. 14 lines 23-55).

**Regarding claim 19**, Ichimura et al. recites the limitations as discussed in claim 17 above, and additionally, the date and hour condition data is tested by the apparatus prior when the user requests to make a copy of a medium. Col. 10, lines 39-58 and col.

14 lines 23-55 teaches a judgment step *prior* to the copying process where the current time is compared to the data set in the date and hour condition data to determine whether to execute the reproduction and copying of audio-visual data on the first medium. Therefore, if a copying process is started prior to the data in the date and time condition data, the process will complete, even though during the copying process, the current time has gone further than the data in the date and time condition data.

**Regarding claim 20**, Ichimura et al. teaches a digital information recording apparatus for recording digital information including video information and/or audio information on a first recording medium, comprising:

a recording circuit for recording information of move permission included in said digital information (Fig. 5, "FREQUENCY CONDITION DATA", "GENERATION CONDITION DATA", col. 11, lines 6-30 and col. 9, lines 48-58 teaches "frequency condition data" and "generation condition data" stored in CMD data that can be recorded onto the source medium or on the copied medium) and permitting, even when said digital information is recorded on said first recording medium and thereafter inhibited from being copied and recorded onto a second recording medium different from said first recording medium, said digital information to be moved to said second recording medium on the premise that at least a part of said digital information on said first recording medium is to be disabled for reproduction (Fig. 5, "FREQUENCY CONDITION DATA", "GENERATION CONDITION DATA" and Col. 11, lines 6-30 teaches sets of data called "frequency condition data" and "generation condition data" which are stored in the CMD data. The generation condition data maybe set to allow

only two generations, therefore, after the source disc is copied a first time, and as taught in col. 9, lines 49-58, the CDM data is updated with new generation condition data in both the source medium (original copy) and the copied medium (second copy). After the copying operation completes, the frequency condition data is updated to "second generation". The second generation of the audio-visual content (within CDM data), stored in either the original copy or the second copy, having met the set limit in generation condition data will therefore be prohibited from any further reproduction or reproduction for copying (col. 11, lines 27-30).

It should be noted that the claimed "move permission" does indeed have to copy the audio-visual content to the second medium in order to facilitate the claimed "move" process. The teaching of Ichimura focuses on making copies of audio-visual content from one medium to another. The teaching of *the last generation copy made* before the system restricts any further reproduction or reproduction for copying meets the limitation of the claimed "move permission". Therefore, the rejection of the current claim addresses all of the limitations as claimed).

**Claim 21** is rejected for the same reasons as discussed in claim 20 above, and furthermore, the "generation condition data" is set to a particular number of generations. During the process of the last generation copy made, the number of future available generation copies reduces from 1 to 0, this thereby represents a "move count".

**Regarding claim 22**, Ichimura et al teaches a digital information reproducing apparatus for reproducing digital information including video information and/or audio information from a first recording medium on which said digital information is recorded,

said digital information including move permission information for permitting, even when said digital information is recorded on said first recording medium and thereafter inhibited from being copied and recorded from said first recording medium onto a second recording medium different from said first recording medium, said digital information to be moved to said second recording medium on the premise that at least a part of said digital information on said first recording medium is disabled for playback (Rejected for the same reasons as discussed above in claim 20), said apparatus comprising:

a detection circuit for detecting the move permission information from the reproduced digital information (col. 4, lines 45-49 teaches of a controller 11 that controls the CMD data read from the source disc 1. Also in col. 5, lines 46-60 teaches of an encoder 23 in conjunction with the controller to detect any CMD data transmitted with the audio-visual data (DT data). The CMD data includes "generation condition data" and "frequency condition data");

a control circuit for controlling, on the basis of said move permission information detected by said detection circuit, an operation for delivering said reproduced digital information so as to move said reproduced digital information to said second recording medium (Col. 4, lines 35-44 and col. 6, lines 3-11 teaches of controllers 11 and 21 that makeup the reproducing portion and the recording portion of the system to allow the audio-visual information from the source medium to be copied onto another medium);  
and



a reproduction disable circuit for disabling at least a part of the digital information on said first recording medium from being reproduced (as discussed in claim 20 above, after the generation of the audio-visual program has met the limit of the set number of generations, the CMD data is updated to prohibit any further copying (col. 11, lines 19-30)).

**Claim 24** is rejected for the same reasons as discussed in claim 21 above.

**Transmitting claim 41** is rejected for the same reasons as discussed in claim 17 above, and furthermore, the audio-visual information and CMD data is transmitted from the reproducing apparatus 10 to recording apparatus 20 (Fig. 1).

**Transmitting claim 42** is rejected for the same reasons as discussed in reproducing claim 22 above, and furthermore, the audio-visual information and CMD data is transmitted from the reproducing apparatus 10 to recording apparatus 20 (Fig. 1).

**Claim 50** is rejected for the same reasons as stated in claim 22 above. The processing of delivering and moving video program from a first medium to a second medium are equivalent.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 26-29, 51-54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura et al. (6,034,832) in view of Kuno (6,584,552).

**Regarding claims 26-29**, Ichimura teaches the limitations as discussed in claim 22 above, however, fails to teach that the device erases encrypted information set in blocks, or units of video or audio programs in the first recording medium.

In an analogous art, Kuno teaches a recording and reproducing apparatus that teaches that when the video program is being reproduced, the encrypted audio and video data are placed in blocks, and when the reproduction has completed for a particular block, the block is deleted (col. 61, line 58 – col. 66, line 24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the deletion of encrypted audio and video data after it is being reproduced as taught by Kuno into the disabling circuit as taught by Ichimura to implement stricter and improved effective copy right protection.

**Claim 51** is rejected for the same reasons as stated in claim 26 above. When the input video program are formed into blocks, and are further erased, it is disabled from being reproduced.

**Claim 52 and 53** are rejected for the same reasons as stated above in claims 27 and 28.

**Claim 54** is rejected for the same reasons as stated above in claim 29, and furthermore Kuno discloses that the information in the blocks are deleted after being played back on the account that the reproduction is interrupted. Therefore the reproduction can be interrupted at any moment, including any time less than 1 minute.

***Allowable Subject Matter***

6. **Claims 23 and 25** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

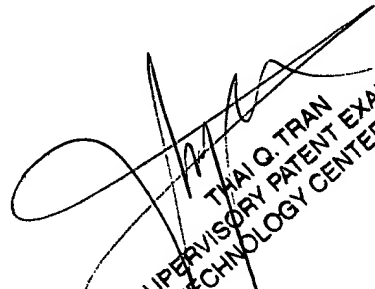
The cited references teach apparatuses that can apply copy restriction practices between first and second copies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gelek Topgyal whose telephone number is 571-272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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